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**Filed** : March 30, 2001

### **REMARKS**

The foregoing amendments and the following remarks are responsive to the July 27, 2005 Office Action. Claims 1, 7, and 11-13 are amended, and Claims 2-6, 8-10, and 14 remain as originally filed. Thus, Claims 1-14 are presented for further consideration. Please enter the amendments and reconsider the claims in view of the following remarks.

#### **Response to Rejection of Claims 1-14 Under 35 U.S.C. § 112, First Paragraph**

In the July 27, 2005 Office Action, the Examiner rejects Claims 1-14 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. The Examiner states that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. In particular, the Examiner states that the specification does not describe a storage device recording an analog signal or overlaying information to the analog signal as recited in the pending claims.

As described herein, Applicant has amended Claims 1, 7, and 11 to more clearly recite the claimed invention. Applicant submits that the as-filed specification and amended Claims 1, 7, and 11, as well as Claims 2-6, 8-10, and 12-14, satisfy the enablement requirement of 35 U.S.C. § 112, first paragraph. As stated in the "Declaration of William B. Boyle Pursuant to 37 C.F.R. § 1.132," submitted herewith, Figure 5 and the corresponding portions of the as-filed specification provide sufficient disclosure to enable one skilled in the art to make and/or use the claimed invention. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 1-14 and pass these claims to allowance.

#### **Response to Rejection of Claims 1-9 and 11-14 Under 35 U.S.C. § 103(a)**

In the July 27, 2005 Office Action, the Examiner rejects Claims 1-9 and 11-14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,587,638 issued to Watanabe et al. ("Watanabe") in view of U.S. Patent No. 6,292,618 issued to Ohara et al. ("Ohara").

##### **Claim 1**

The Examiner states that Watanabe discloses all the limitations of Claims 1-9 and 11-14 except for a tuner for selecting a program. The Examiner further states that Ohara discloses a tuner used as an input to select programs. As described herein, Applicant has amended Claim 1 to recite (emphasis added):

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1. A video system for presenting content from a content provider to a user, comprising:

a tuner configured to select a program from a plurality of programs, wherein **the tuner transmits a first analog signal representing the selected program via a first connection and transmits a second analog signal representing the selected program via a second connection;**

an analog output port coupled to the tuner via the first connection to receive the first analog signal representing the selected program from the tuner, wherein **the analog output port is configured to be connectable to a storage device to transmit the first analog signal representing the selected program to the storage device;**

**an analog signal processing circuit** coupled to the tuner via the second connection to receive the second analog signal representing the selected program from the tuner and **to generate a digital representation of the second analog signal;**

a first interface module configured to be connectable to the storage device to receive recorded programs from the storage device; and

an overlay module coupled to the analog signal processing circuit and to the first interface module, the overlay module configured to selectively overlay information to a program received from one of the analog signal processing circuit and the first interface module.

Applicant submits that the combination of Watanabe and Ohara does not disclose or suggest the video system recited by amended Claim 1. For example, Applicant submits that the combination of Watanabe and Ohara does not disclose or suggest a tuner which “transmits a first analog signal representing the selected program ... and transmits a second analog signal representing the selected program,” an analog output port which “is configured to be connectable to a storage device to transmit the first analog signal representing the selected program to the storage device,” and an analog signal processing circuit which “generate[s] a digital representation of the second analog signal.”

The Examiner acknowledges that Watanabe does not disclose or suggest using a tuner for selecting a program, but states that it would be obvious to modify Watanabe by using the tuner disclosed by Ohara as an input. However, Applicant submits that the tuner disclosed by Ohara does not disclose or suggest a tuner as recited by amended Claim 1. The tuner of amended Claim 1 “transmits a **first analog signal** representing the selected program via a first connection and transmits a **second analog signal** representing the selected program via a second connection” (emphasis added). Amended Claim 1 further recites that the analog output port is coupled to the tuner via the first connection and the analog processing circuit is coupled to the tuner via the second connection. As shown in Figure 21 of Ohara, the analog broadcast receiving

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tuner 12 transmits the analog signal only to the input change-over switches 13. Therefore, Applicant submits that Ohara does not disclose or suggest the tuner of amended Claim 1 which is not disclosed or suggested by Watanabe.

Applicant further submits that the combination of Watanabe and Ohara does not disclose or suggest the “analog output port” or the “analog signal processing circuit” recited by amended Claim 1. As recited by amended Claim 1, the analog output port is “coupled to the tuner via the first connection to receive the first analog signal,” and the analog signal processing circuit is “coupled to the tuner via the second connection to receive the second analog signal.” In the July 27, 2005 Office Action, the Examiner identifies the video decoder 9 and the digital interface 10 of the apparatus disclosed by Watanabe as corresponding to the “analog signal processing circuit” of the claimed invention. The Examiner also identifies the MPEG2 encoder 11, the DVTR interface 14, and the DVTR processor 15 of the apparatus disclosed by Watanabe as corresponding to the “analog output port” of the claimed invention. However, the “analog output port” and the “analog signal processing circuit” identified by the Examiner are in **series** with one another (*see* Figure 1 of Watanabe), so they do not satisfy the limitation that they are coupled to the tuner via a first connection and a second connection, respectively. In addition, since the “analog output port” identified by the Examiner is downstream of the “analog signal processing circuit,” which generates a **digital signal** (*see, e.g.,* Figure 1 and column 6, lines 32-44 of Watanabe), the “analog output port” identified by the Examiner does not satisfy the limitation of amended Claim 1 that the “analog output port ... receive[s] the first **analog signal** ... from the tuner” (emphasis added). Furthermore, Ohara does not disclose or suggest an “analog output port” and an “analog signal processing circuit” coupled to the tuner via a first connection and a second connection, respectively, as recited by amended Claim 1.

For at least the foregoing reasons, Applicant submits that the combination of Watanabe in view of Ohara does not disclose or suggest all the limitations of amended Claim 1, so amended Claim 1 is patentably distinguished over Watanabe in view of Ohara. Applicant respectfully requests that the Examiner withdraw the rejection of Claim 1 and pass Claim 1 to allowance.

#### Claims 2-9

Each of Claims 2, 4, and 6 depends from amended Claim 1, Claim 3 depends from Claim 2, Claim 5 depends from Claim 4, each of Claims 7 and 8 depends from Claim 6, and Claim 9 depends from Claim 8. Therefore, each of Claims 2-9 includes all the limitations of

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amended Claim 1 as well as other limitations of particular utility. For at least the reasons discussed above with respect to amended Claim 1, Applicant submits that Claims 2-9 are patentably distinguished over Watanabe in view of Ohara. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 2-9 and pass these claims to allowance.

#### Claim 11

Applicant has amended Claim 11 to recite (emphasis added):

11. A method of presenting content from a content provider to a user, comprising:
- selecting a program from a plurality of programs;
  - transmitting a first analog signal representing the selected program via a first connection and transmitting a second analog signal representing the selected program via a second connection;**
  - transmitting the first analog signal representing the selected program to a storage device via an analog output for recording the selected program on the storage device;**
  - converting the second analog signal representing the selected program to a digital representation of the second analog signal; and**
  - overlaying information to one of the selected program represented by the second analog signal and a recorded program retrieved from the storage device.

As discussed above, neither Watanabe nor Ohara disclose or suggest “transmitting a first analog signal representing the selected program via a first connection and transmitting a second analog signal representing the selected program via a second connection.” Furthermore, neither Watanabe nor Ohara disclose or suggest “providing the first analog signal ... at an analog output port ... [and] converting the second analog signal ... to a digital representation,” for reasons similar to those discussed above. Therefore, Applicant submits that amended Claim 11 is patentably distinguished over Watanabe in view of Ohara. Applicant respectfully requests that the Examiner withdraw the rejection of amended Claim 11 and pass amended Claim 11 to allowance.

#### Claims 12-14

Each of Claims 12 and 13 depends from amended Claim 11, and Claim 14 depends from Claim 13. Therefore, each of Claims 12-14 includes all the limitations of amended Claim 11 as well as other limitations of particular utility. For at least reasons similar to those discussed above with regard to amended Claim 11, Applicant submits that Claims 12-14 are patentably

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distinguished over Watanabe in view of Ohara. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 12-14 and pass these claims to allowance.

**Response to Rejection of Claim 10 Under 35 U.S.C. § 103(a)**

In the July 27, 2005 Office Action, the Examiner rejects Claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of Ohara in further view of U.S. Patent No. 6,741,798 issued to Maruyama et al. ("Maruyama").

As described above, Applicant submits that amended Claim 1 is patentably distinguished over Watanabe in view of Ohara. Applicant submits that Maruyama does not disclose or suggest the limitations of amended Claim 1 which are not disclosed or suggested by Watanabe in view of Ohara. Therefore, Applicant submits that amended Claim 1 is patentably distinguished over Watanabe in view of Ohara in further view of Maruyama.

Claim 10 depends from Claim 9, which depends from Claim 8, which depends from Claim 6, which depends from amended Claim 1. Therefore, Claim 10 includes all the limitations of amended Claim 1 as well as other limitations of particular utility. For at least the reasons discussed above in relation to amended Claim 1, Applicant submits that Claim 10 is patentably distinguished over Watanabe in view of Ohara in further view of Maruyama. Applicant respectfully requests that the Examiner withdraw the rejection of Claim 10 and pass Claim 10 to allowance.

**Summary**

For the foregoing reasons, Applicant submits that Claims 1-14 are in condition for allowance, and Applicant respectfully requests such action.

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By: 

Bruce S. Itchkawitz  
Registration No. 47,677  
Attorney of Record  
2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
(949) 760-0404

1951704  
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